

PATENT
Serial No. 10/525,138

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of Atty. Docket
Darwin HE, et al. NL 020795US
Confirmation No. 1795
Serial No. 10/525,138 Group Art Unit: 2434
Filed: February 16, 2005 Examiner: SANDERS, Stephan
Title: COMMUNICATION SYSTEM AND METHOD BETWEEN A RECORDING
AND/OR REPRODUCING DEVICE AND A REMOTE UNIT

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Board of Patent Appeals and Interferences
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APPELLANTS' REPLY BRIEF

Sir:

In response to the Examiner's Answers mailed on November 22, 2010, please consider the following remarks:

REMARKS

Appellants maintain the arguments submitted in the Appeal Brief filed on October 28, 2010, which is incorporated herein by reference. Further, Appellants refute the allegations made in the Examiner's Answer of November 22, 2010.

In particular, in the Response to Argument section beginning on page 14 of the Examiner's Answer of November 22, 2010, it is alleged that the present invention as recited in the claims is obvious over WO 01/90860 (Schwartz) in view of U.S. Patent No. 6,405,203 (Collart) and U.S. Patent Application Publication No. 2003/0110192 (Valente), partly because Schwartz discloses on page 14, lines 3-9 (see also page 15, Examiner's Answer lines 6-12):

Those skilled in the art will appreciate that although these are examples of multimedia data, other types of corresponding data other than multimedia (e. g., program codes, encrypted data, etc.) may also be utilized in accordance with a preferred embodiment of the present invention. The unique identifying indicia is a unique identifier derived from information stored on the physical removable media itself. In a preferred embodiment, the unique identifier is based on the "Red Book"audio standard, well-known in the electronic recording arts. (Emphasis added)

As previously noted in the Appeal Brief filed on October 28, 2010, Schwartz is directed to a method for authenticating that a specified pre-recorded media (e.g., CD) is inserted into a drive for granting access to restricted content related to a specific prerecorded media. As recited on page 2, lines 10-17, the Schwartz method authenticates a CD by "generating a unique identifier from the contents." (Schwartz, page 2, line 12;

emphasis added) The "unique identifier [is passed] to a verification script on the Internet." (Schwartz, page 5, line 10; emphasis added) A bonus track is downloaded to the user's computer if "the unique identifier that is sent from the user's computer matches the identifier of the audio CD that is qualified for the download (Schwartz, page 5, line 21-22; emphasis added)

As correctly noted on page 5, last paragraph of the Final Office Action, and page 15, lines 4-5 of the Examiner's Answer, Schwartz does not disclose or suggest using memory medium properties that includes the region code of the memory medium for "authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider," as recited in independent claim 1, and similarly recited in independent claims 5-6 and 8-9. However, page 15 of the Examiner's Answer alleges that this feature is obvious because Schwartz discloses authenticating a CD using "a unique identifier derived from information stored on the physical removable media itself. In a preferred embodiment, the unique identifier is based on the "Red Book" audio standard, well-known in the electronic recording arts, where the "Red Book" audio standard states "that the International Standard Recording Code (ISRC), which represents the country region code, should be included on the disc." (Examiner's Answer, page 15, last full paragraph, lines 1-3)

At the outset, assuming arguendo that the Red Book audio standard provides for including the country code on a disc, it is respectfully submitted that the Red Book audio

standard provides details about just about everything that can be stored on a disk, and does not add anything to the currently cited prior art references. Using the Red Book audio standard to allege that it is obvious to use one of many items stored on the disc for disc authentication is akin to alleging that a large genus renders a claim to a particular species obvious.

It is respectfully submitted that a large genus does not render a claim to a particular species obvious, as noted in *In re Baird*, 16 F3d. 380, 29 USPQ2d 1550 (Fed Cir. 1994), where it is recited that a “disclosure of millions of compounds does not render obvious a claim to three compounds.” Further, in *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (C.C.P.A. 1958), the CCPA reversed the Board’s opinion noting:

To rely on an equivalence known only to the applicant to establish obviousness is to assume that his disclosure is a part of the prior art. The mere statement of this proposition reveals its fallaciousness...To sum it all up, actual equivalence is not enough to justify refusal of a patent on one member of a group when another member is in the prior art. The equivalence must be disclosed in the prior art or be obvious within the terms of Section 103. (*Id.* at 347-348)

Further, it is respectfully submitted that a disclosure of disc authentication using disc properties complying with the Red Book audio standard, where one of the many such properties may be the country code, does not render obvious to actually use the country code for authentication. Otherwise, for example, any processor, which is capable of using one of many properties or input data to perform any function if programmed to do so, may be deemed prior art to a particular processor which is specifically configured to perform a

specific function using a specific input data or property recited in a claim.

Even further, assuming arguendo, that it is obvious from Schwartz and the Red Book audio standard to use the disc country code for authentication, Schwartz specifically discloses to use disc properties to generate "a unique identifier" which is unique to the disc and is used to authenticate the disc.

In stark contrast, the present invention as recited in independent claim 1, and similarly recited in independent claims 5-6 and 8-9, amongst other patentable elements recites (illustrative emphasis provided):

authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device,...

wherein the memory medium properties include a region code of the memory medium.

The memory medium, as recited in the independent claims, is authenticated if its region code matches the region code of a corresponding memory medium legally produced by a provider. In contrast to Schwartz, a unique identifier is NOT used to authenticate the disc; rather the region code is used which shared by many other discs and is not unique. The memory medium recited in the independent claims is authenticated if its region code matches the region code of another memory medium.

Authenticating a memory medium by comparing its memory medium properties, that includes the disc region code, with corresponding properties of a corresponding memory medium legally produced by a provider, as recited in the independent claim is nowhere

disclosed or suggested in Schwartz, Collart and Valente.

Based on the foregoing, it is respectfully requested that the rejection under 35 U.S.C. §103(a) of independent claims 1, 5-6 and 8-9 be reversed, and independent claims 1, 5-6 and 8-9 be allowed. In addition, it is respectfully submitted that claims 2, 4, 10-15, 18 and 20-25 should also be allowed at least based on their dependence from independent claims 1 and 5-6.

In addition, Appellants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Appellants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

CONCLUSION

Claims 1-2, 4-6, 8-15, 18 and 20-25 are patentable over Schwartz, Collart and Valente.

Thus, the Examiner's rejections of claims 1-2, 4-6, 8-15, 18 and 20-25 under 35 U.S.C. §103(a) over Schwartz, Collart and Valente should be reversed.

Respectfully submitted,

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